Termguard Pty Ltd & Anor v Rapidkill Pest Control (KL) Sdn Bhd

HIGH COURT (KUALA LUMPUR) — CIVIL SUIT NO WA-22IP-26–04 OF 2020
MOHD RADZI HARUN J
3 FEBRUARY 2025

Copyright — Infringement — Passing off — Whether plaintiff failed to prove that defendant had infringed plaintiff's copyright in its works or had committed tort of passing off or had unlawfully interfered with plaintiff's trade or business

Both the plaintiffs and the defendant were in the business of making and selling a reticulation system to control subterranean termites. In this suit, the plaintiffs claimed that the defendant had: (a) infringed the plaintiffs' copyright in the pictures, drawings, diagrams and literature relating to the termite control system devised by the plaintiff ('the plaintiffs' works') by reproducing the same without the plaintiffs' consent in the defendant's termite control system ('the defendant's infringing work'); (b) unlawfully sold or offered to sell the defendant's infringing work or had used the same in its tender project documents; and (c) committed the tort of passing off and had unlawfully interfered with the plaintiffs' trade or business. The plaintiffs sought: (i) a permanent injunction to prevent the defendant from continuing to infringe the plaintiffs' works in any form; (ii) an order that the defendant deliver up all reproductions of the plaintiffs' works and the relevant documents or products that infringed the copyright in the plaintiffs' works; (iii) order the defendant to disclose its suppliers or potential suppliers, customers or potential customers and all their detailed particulars; and (iv) damages.

Held, dismissing the plaintiffs' claims against the defendant:

(1) The plaintiffs had proven on balance of probabilities that copyright subsisted in the plaintiffs' works, that the first plaintiff was the lawful owner of that copyright and that the plaintiffs had the locus standi to bring this action against the defendant. The defendant failed to adduce any positive evidence to displace the plaintiffs' evidence of copyright ownership (see paras 2, 28, 45 & 84).

(2) The defendant had not infringed the copyright in the plaintiffs' works, nor did it commit the tort of passing off or unlawfully interfere with the plaintiffs' trade. All claims made by the plaintiffs against the defendant in this action were dismissed (see paras 84–85).

(3) The plaintiffs failed to show that there were substantial objective similarities between the defendant's infringing work and the plaintiffs' works. The objective similarities that existed were only minor in nature in that they both contained reticulated coils. As the element of substantial objective similarities was not proven, the court did not need to consider if the other two elements necessary to prove copyright infringement had been proven (namely, whether there was a causal connection between the original work and the infringing copy and whether what had been infringed constituted a substantial part of the original work). The conclusion that had to be drawn was that there was no infringement by the defendant of the copyright in the plaintiffs' works (see paras 51 & 59–60).

(4) To succeed on the tort of passing off, the plaintiffs had to establish that: (a) goodwill or reputation attached to the plaintiffs' works because they were known to buyers by some distinctive get up or features; (b) there was misrepresentation by the defendant which was likely to lead the public to believe that the goods sold by the defendant were those of the plaintiffs'; and (c) the plaintiffs had suffered or would suffer loss due to the defendant's misrepresentation. The reticulated coil system was not a distinctive get up or feature of the plaintiffs' termite control system. Buyers bought the system because it was functional and utilitarian. No consumer would be able to tell that a particular termite control system belonged to the plaintiffs, even by looking at the reticulated coil design. The consumer would only be able to do so by identifying the plaintiffs' brand name emblazoned on their termite control system. As the plaintiffs had not satisfied the burden of proving distinctiveness in the plaintiffs' works, the element of goodwill and reputation attaching to the plaintiffs' works had not been proven (see paras 63, 65 & 69–70).

(5) The reticulation coil applied in the plaintiffs' termite control system was common and not distinctive. Concerned members of the public would not be confused or deceived into believing that the defendant's products, even if they carried the reticulation coil system, were that of the plaintiffs'. There was no misrepresentation by the defendant. The defendant's logo depicted clearly the defendant's brand. No ordinary sensible member of the public would be deceived into thinking that they were buying the Termguard termite control system when they paid for Rapidkill termite control system (see paras 74–75).

(6) There was no mala fide intent in the defendant's website copying the plaintiff's website as the court accepted, on balance of probabilities, DW1's testimony that the defendant's website was created using the plaintiff's website as a reference (see para 76).

(7) The plaintiffs had failed to prove that the defendant had interfered with their trade or business by unlawful means and with the intention of injuring the plaintiffs (see para 83).

[Bahasa Malaysia summary

Plaintif-plaintif dan defendan terlibat dengan perniagaan membuat dan menjual sistem retikulasi untuk mengawal anai-anai bawah tanah. Dalam saman ini, plaintif-plaintif menyatakan bahawa bahawa defendan telah: (a) melanggar hak cipta plaintif-plaintif dalam gambar, lukisan, gambar rajah dan tulisan yang berkaitan dengan sistem kawalan anai-anai yang direka oleh plaintif ('karya plaintif-plaintif') dengan menghasilkan semula karya tersebut tanpa persetujuan plaintif dalam sistem kawalan anai-anai defendan ('karya defendan yang melanggar'); (b) secara salah menjual atau menawarkan karya defendan yang melanggar atau telah menggunakannya dalam dokumen projek tendernya; dan (c) melakukan tort kelirupaan ('passing off') dan telah mengganggu perdagangan atau perniagaan plaintif secara tidak sah. Plaintif-plaintif memohon: (i) injunksi kekal untuk menghalang defendan daripada terus melanggar karya plaintif dalam apa jua bentuk; (ii) perintah bahawa defendan menyerahkan semua pengeluaran semula karya plaintif-plaintif dan dokumen atau produk yang berkaitan yang melanggar hak cipta dalam karya plaintif; (iii) memerintahkan defendan untuk mendedahkan pembekal atau bakal pembekalnya, pelanggan atau bakal pelanggan dan semua butiran terperinci mereka; dan (iv) ganti rugi.

Diputuskan, menolak tuntutan-tuntutan plaintif-plaintif terhadap defendan:

(1) Plaintif-plaintif telah membuktikan berdasarkan keseimbangan kebarangkalian bahawa hak cipta wujud dalam karya plaintif-plaintif dan plaintif pertama adalah pemilik sah hak cipta itu dan bahawa plaintif-plaintif mempunyai locus standi untuk membawa tindakan ini terhadap defendan. Defendan gagal mengemukakan sebarang bukti positif untuk menggantikan bukti pemilikan hak cipta plaintif (lihat perenggan 2, 28, 45 & 84).

(2) Defendan tidak melanggar hak cipta dalam karya plaintif-plaintif dan juga tidak melakukan tort kelirupaan ('passing off') atau mengganggu perdagangan plaintif secara tidak sah. Semua tuntutan yang dibuat oleh plaintif terhadap defendan dalam tindakan ini telah ditolak (lihat perenggan 84–85).

(3) Plaintif-plaintif gagal menunjukkan bahawa terdapat persamaan objektif yang ketara antara karya defendan yang melanggar dan karya plaintif-plaintif. Persamaan objektif yang wujud hanya bersifat kecil iaitu kedua-duanya mengandungi gegelung retikulasi. Oleh kerana unsur persamaan objektif yang substansial tidak dibuktikan, mahkamah tidak perlu mempertimbangkan sama ada dua elemen lain yang diperlukan

untuk membuktikan pelanggaran hak cipta telah dibuktikan (iaitu, sama ada terdapat hubungan kausal antara karya asal dan karya yang melanggar dan sama ada karya yang dilanggar merupakan sebahagian besar daripada karya asal). Kesimpulan yang perlu dibuat adalah bahawa tiada pelanggaran hak cipta oleh defendan dalam karya plaintif-plaintif (lihat perenggan 51 & 59–60).

(4) Untuk berjaya dalam tort kelirupaan ('passing off'), plaintif-plaintif perlu membuktikan bahawa: (a) nama baik atau reputasi wujud pada karya plaintif-plaintif yang diketahui oleh pembeli dengan beberapa penampilan atau ciri tersendiri; (b) terdapat salah nyata oleh defendan yang mungkin menyebabkan orang ramai mempercayai bahawa barangan yang dijual oleh defendan adalah barangan plaintif-plaintif; dan (c) plaintif-plaintif telah mengalami atau akan mengalami kerugian akibat salah nyata defendan. Sistem gegelung retikulasi bukanlah perolehan atau ciri tersendiri dalam sistem kawalan anai-anai plaintif-plaintif. Pembeli membeli sistem itu kerana ianya berfungsi dan bersifat membawa manfaat yg paling besar kepada seberapa ramai orang. Tiada pengguna akan dapat memberitahu bahawa sistem kawalan anai-anai tertentu adalah milik plaintif-plaintif walaupun dengan melihat reka bentuk gegelung retikulasi. Pengguna hanya boleh berbuat demikian dengan mengenal pasti nama jenama plaintif-plaintif yang terpampang pada sistem kawalan anai-anai mereka. Oleh kerana plaintif tidak memenuhi beban pembuktian keistimewaan dalam karya-karya plaintif-plaintif, elemen nama baik dan reputasi yang terdapat pada karya-karya plaintif-plaintif juga tidak dibuktikan (lihat perenggan 63, 65 & 69–70).

(5) Gegelung retikulasi yang digunakan dalam sistem kawalan anai-anai plaintif-plaintif adalah biasa dan bukanlah unik. Orang awam tidak akan keliru atau tertipu untuk mempercayai bahawa ianya adalah produk defendan, walaupun produk plaintif menggunakan sistem gegelung retikulasi tersebut. Tiada salah nyata oleh defendan. Logo defendan menggambarkan dengan jelas jenama defendan. Tiada orang awam biasa yang bijak akan tertipu dengan berfikir bahawa mereka membeli sistem kawalan anai-anai Termguard ketika membeli sistem kawalan anai-anai Rapidkill (lihat perenggan 74–75).

(6) Tiada niat mala fide di laman web defendan yang meniru laman web plaintif kerana mahkamah menerima berdasarkan keseimbangan kebarangkalian dan keterangan DW1 bahawa laman web defendan dibuat menggunakan laman web plaintif-plaintif sebagai rujukan (lihat perenggan 76).

(7) Plaintif-plaintif telah gagal membuktikan bahawa defendan telah mengganggu perdagangan atau perniagaan mereka dengan cara yang menyalahi undang-undang dan dengan niat untuk merugikan

plaintif-plaintif (lihat perenggan 83).]

Cases referred to

Alfa Laval (M) Sdn Bhd v Ng Ah Hai & Ors [2008] 5 MLJ 344; [2009] 7 CLJ 1, HC (folld)

Aventis Farma Sa (M) Sdn Bhd & Anor v Rohibul Sabri bin Abas @ Megat (t/a as Dabur Enterprise) & Anor [2008] 3 MLJ 451, HC (refd)

Batu Kemas Industri Sdn Bhd v Kerajaan Malaysia Tenaga Nasional Bhd [2015] 5 MLJ 52; [2015] 7 CLJ 849, CA (refd)

Chong Kak Hau v PP [2009] 8 CLJ 10; [2008] 1 LNS 734, HC (refd)

Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor [2015] 3 MLJ 1, FC (refd)

Elster Metering Ltd & Anor v Damini Corp Sdn Bhd & Anor [2011] 8 MLJ 253; [2010] 1 LNS 397, HC (refd)

H & R Johnson (Malaysia) Bhd v H & R Johnson Tiles Ltd & Anor [1995] MLJU 54; [1995] 2 CLJ 581, HC (refd)

Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor [2012] 8 CLJ 645, CA (refd)

Honda Giken Kogyo Kabushiki Kaisha v Mforce Bike Holdings Sdn Bhd & Anor and another suit [2017] MLJU 1576, HC (refd)

Junaidi bin Abdullah v PP [1993] 3 MLJ 217; [1993] 4 CLJ 201, SC (refd)

Longman Malaysia Sdn Bhd v Pustaka Delta Pelajaran Sdn Bhd [1987] 2 MLJ 359; [1986] 1 LNS 84 (folld)

Ly Furniture Sdn Bhd & Anor v Lifestyle Enterprise, Inc & Anor and another appeal [2015] MLJU 2347; [2015] 1 LNS 1557, CA (refd)

Malaysian Newsprint Industries Sdn Bhd v Bechtel International Inc & Anor [2013] MLJU 866, HC (refd)

Megnaway Enterprise Sdn Bhd v Soon Lian Hock [2002] MLJU 433; [2003] 5 CLJ 103, HC (refd)

Meidi (M) Sdn Bhd v Meidi-Ya Co Ltd, Japan & Anor [2008] 6 MLJ 433; [2008] 1 CLJ 46, CA (folld)

Meidi-Ya Co Ltd, Japan & Anor v Meidi (M) Sdn Bhd [2009] 2 MLJ 14; [2009] 2 CLJ 15, FC (refd)

Microsoft Corp v Conquest Computer Centre Sdn Bhd [2015] 7 MLJ 243, HC (refd)

Microsoft Corporation v Yong Wai Hong [2008] 3 MLJ 309; [2008] 6 CLJ 223, CA (refd)

Ortus Expert White Sdn Bhd v Nor Yanni bt Adom & Anor [2022] 2 MLJ 67; [2022] 2 CLJ 661, FC (refd)

Polivitte Ltd v Commercial Union Assurance Co Plc [1987] 1 Llyod's Rep 379, QBD (refd)

Rajagopal a/l Santhanam v PP [1998] MLJU 250; [1998] 1 LNS 485, HC (refd)

J, Re [1991] FCR 370, CA (refd)

Reckitt & Colman Products Ltd v Borden Inc And Others [1990] IAU R 877; [1990] LRC (Comm) 417, HL (refd)

Rock Records (M) Sdn Bhd v Audio One Entertainment Sdn Bhd [2005] 3 MLJ 552; [2005] 1 CLJ 200, HC (refd)
Thye Huat Chan Sdn Bhd v Thye Shen Trading Sdn Bhd & Anor [2008] 6 MLJ 99; [2008] 6 CLJ 915, HC (refd)
Whitehouse v Jordan [1981] 1 WLR 246; [1981] 1 All ER 267, HL (refd)
YKL Engineering Sdn Bhd v Sungei Kahang Palm Oil Sdn Bhd & Anor [2022] 6 MLJ 1; [2022] 8 CLJ 32, FC (folld)
Yong Sze Fun & Anor (t/a Perindustrian Makanan & Minuman Layang-Layang) v Syarikat Zamani Hj Tamin Sdn Bhd & Anor [2012] 1 MLJ 585; [2011] 1 LNS 1307, CA (refd)

Legislation referred to

Copyright Act 1987 ss 3, 7, 7(1), (1)(c), (3), (3)(a), (4), 10, 10(1), (2), 26, 27(3), (4), (5), (6), 38(2), (3), 42, 42(2)
Rules of Court 2012 O 41 r 12

Lourdes Abishegam (with Nga Koo Koy) (Ngeh & Co) for the plaintiffs.
Maggie Khon Chee Peng (with Choo Hong Seng and Chong Xin Tian) (CP Khon & Tan) for the defendant.

Mohd Radzi Harun J:

INTRODUCTION

[1] In this suit, the plaintiffs claim:

(a) ownership of the copyright under the Copyright Act 1987 ('the CA 1987') that they argued subsists in the expression of idea in the pictures, drawings and diagrams (including the literatures) of the components of termite control constituting an underground reticulation system of termite control as enumerated in paras 11(a)–(c) of their amended statement of claim ('the plaintiffs' works');

(b) infringement of the copyright of the plaintiffs' works by the defendant through the reproduction of the same in the defendant's termite reticulation system or otherwise from such works ('the defendant's infringing work');

(c) the defendant was unlawfully selling the defendant's infringing work or offering to sell the same;

(d) the defendant unlawfully used the defendant's infringing work in its tender project documents;

(e) the defendant was reproducing the plaintiffs' works without the plaintiffs' license and permission; and

(f) the defendant had committed the tort of passing off and unlawful

interference with the plaintiffs' trade or business by causing confusion or attempt to cause confusion in the termite reticulation components and drawing as found in the defendant's infringing work which carry high degree of similarity or sufficient similarities and casual connection or substantial similarity of the plaintiffs' works. This is particularly so in the literature and artistic works appear in the drawing and the diagram of the components of the defendant's infringing work showing the location of the two-hole system in the defendant's infringing work, similar with the two-hole system found in the plaintiffs' works.

[2] This court had partially allowed the plaintiffs' claims and declared that copyright subsists in the plaintiffs' works and that the first plaintiff is the lawful owner of the copyright in the plaintiffs' works.

[3] The defendant's appeal is against this court's decision that:

(a) copyright subsists in the plaintiffs' works; and

(b) the first plaintiff is the lawful owner of the copyright of the plaintiffs' works.

[4] The plaintiffs appeal is against the part of this court's decision that decided that the defendant did not infringe the plaintiffs' copyright and that the plaintiffs' case against the defendants was dismissed with costs.

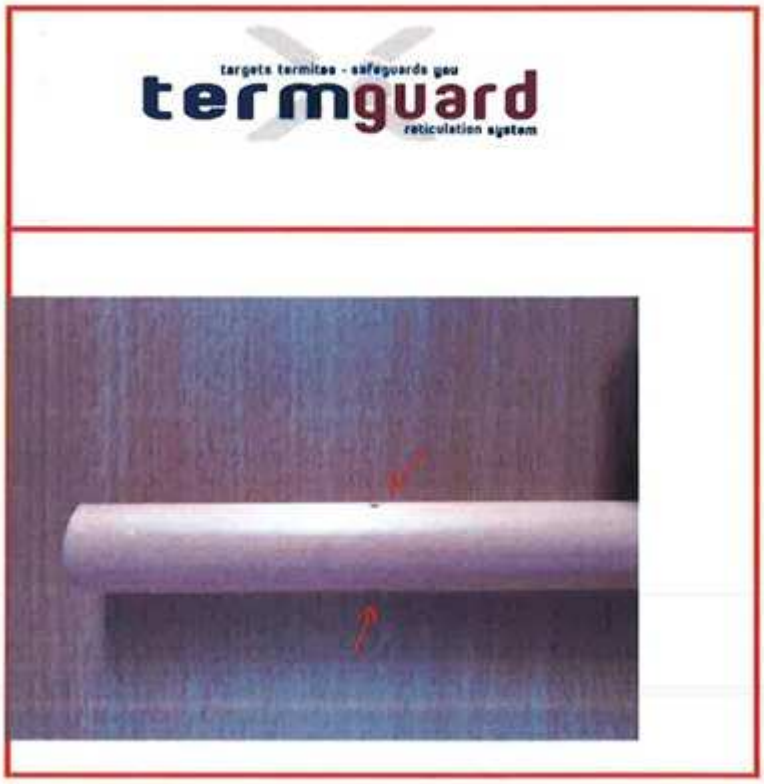
[5] This grounds shall apply to both appeals.

THE CLAIM

[6] The plaintiffs alleged that the defendant, without the plaintiffs' permission, consent or license, had reproduced the plaintiffs' works as below:

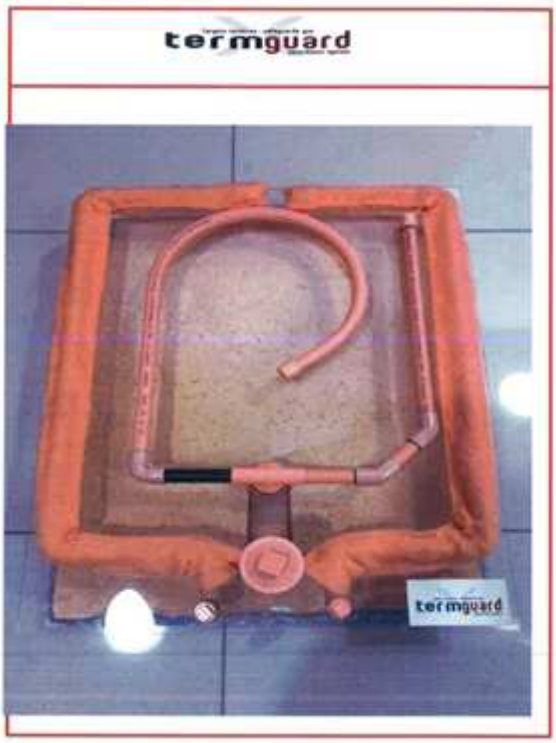
(a) the two-hole system created, owned and used by the first plaintiff as below:

(the remainder of this page is intentionally left blank)



(b) the reticulation system created, owned and used by the plaintiffs as shown below:

(the remainder of this page is intentionally left blank)



(c) the diagrams and screens as shown below which are screenshots extracted from the plaintiffs' website existed since 2007 describing the two-hole system created, owned and used by the plaintiffs:

(the remainder of this page is intentionally left blank)

termguard
termguard.com/singapore/termguard-simp-facts.html
termguard
Adobe Flash Player is blocked
Q. How do the Termguard systems work?
A. With Termguard's uniquely designed equipment and formulated Termite Control Agent, the system is able to deliver a safe and equal distribution of termiticide around your home or building. In doing so, the Termite Control Agent will repeal and/or eradicate the termites around your home or building.
Termguard Systems distributes solution with minimal variation. Holes are placed in the top 20% of the pipe which are installed facing upwards. This enables the system pipe to fill up first and then emit the solution.
These diagrams show the placement of the holes in a cross section view.

Q. Does the home/building owner have to be present when replenishing the termite management agent?

A. Termguard Systems are injected or replenished via external injection points which are located in the pathway or garden bed or landscaping of the building and are protected by a locked child proof trap. Therefore, the home or building owner is not required to be present at the time of replenishment however; all inspections require full internal and external access to the building.

Q. How are the holes in the perforated perimeter pipe kept free from obstructions, especially construction fill?
A. By the use of Permecover - a GeoFabric non-woven mat, it keeps the construction fill from blocking the perforated pipe.

[7] All the above had been particularised in paras 11(a), (b) and (c) of the plaintiiffs' amended SOC.

[8] The plaintiffs' case is that the first plaintiff has expanded sufficient effort, skill, labour and costs to make the plaintiffs' work original in character. The second plaintiff is the sole and only licensee of the first plaintiff that is permitted to operate trade and business using the plaintiffs' works in Malaysia.

[9] Around September 2019, the defendant submitted tender documents for providing services relating to termite's treatment to a construction project at Hospital Kemaman. The plaintiffs alleged that the defendant, without any permission, consent or licence of the plaintiffs, reproduced the plaintiffs' works in the tender documents.

[10] Based on the alleged unlawful act of reproduction of the plaintiffs' works by the defendant, the plaintiffs claimed against the defendant for copyright infringement of the plaintiffs' works, passing off and unlawful interference with the plaintiffs' trade and business.

[11] The plaintiffs sought for, among others, the following reliefs:

(a) permanent injunction to prevent the defendant from continuing to infringe the plaintiffs' works in any form;

(b) delivery up order of all the defendant's reproductions of the plaintiffs'

works, and the relevant documents or products that infringed the copyright of the plaintiffs' works;

(c) disclosure of the defendant's suppliers or potential supplier, customers or potential customers and all their detailed particulars; and

(d) damages.

FINDINGS

Patent

[12] The defendant argued that although the plaintiffs' claims against the defendant is premised on copyright, the plaintiffs' claims must fail as they relied heavily on the first plaintiff's patent registrations in foreign countries relating to the first plaintiff's termite replenishment or reticulation system. Apart from the differing laws governing copyright and patent, the patents were granted to the first plaintiff by foreign authorities and not registered under Malaysian patent law. On top of that, the patent registrations had expired. As such those patents are irrelevant and cannot be recognised by this court: *Aventis Farma Sa (M) Sdn Bhd & Anor v Rohibul Sabri bin Abas @ Megat (t/a as Dabur Enterprise) & Anor* [2008] 3 MLJ 451). The defendant argued that the patents referred to by the plaintiffs render no assistance to the plaintiffs' case against the defendant.

[13] I agree with the defendant's arguments to the extent that the plaintiffs' pleadings on the patents granted to the first plaintiff cannot assist the plaintiffs' case.

[14] This court relied on the decision of the Federal Court in *YKL Engineering Sdn Bhd v Sungei Kahang Palm Oil Sdn Bhd & Anor* [2022] 6 MLJ 1; [2022] 8 CLJ 32 — which was also referred to in the defendant's counsel submission in reply — in determining the principle applicable to deny plaintiffs' claim for copyright in the plaintiffs' works based on the first plaintiff's patents, where the Federal Court held:

> [97] We agree with the appellant that the test applicable on the subsistence of the copyright is not 'newness' or 'novelty'. This too seems to be the position taken by the respondents. The different legal test in patent and copyright was explained by the High Court in *Radion Trading Sdn Bhd v Sin Besteam Equipment Sdn Bhd & Ors* [2010] 9 MLJ 648; [2010] 6 CLJ 334. Clearly deliberated by Azahar Mohamed J (now CJM) in that case, patent and copyright are two distinct fields of intellectual property law. The basis of patent is the novelty of the subject invention and the notion of originality in copyright law is not the same as novelty found in patent law. His Lordship in that case had clarified clearly this legal proposition in the following way:
>
> It is incorrect to employ the claims in a patent specification to regulate or limit

A the scope of copyright protection over an artistic work of a device, which may incidentally correlate or form part of the patented invention.

[15] Having scrutinised the plaintiffs' pleadings, particularly paras 5 and 6 of the plaintiffs' amended SOC where the issue of patents were raised, this court found that the pleadings served to demonstrate the first plaintiff's involvement on the termite proofing installation techniques which include the termite-proofing method implemented through a pipe system comprising two sub-systems of tubes. The plaintiffs also intended to show that they had created this system in Australia since 1985, proven through the registered patents in Australia, the US and Japan.

[16] Despite all that shown by the plaintiffs in those paragraphs of their pleadings, this court decides on the plaintiffs' claims against the defendant solely on the applicable laws relating to copyright. Those facts pertaining to patent do not in any manner formed the basis for this court's findings on the plaintiffs' claims against the defendant.

PW1's affidavit must be rejected?

[17] The defendant argued that the affidavit of the plaintiffs' expert, Junichiro Katayama (PW1), is defective as it was not affirmed before a Consular officer, in breach of O 41 r 12 of the Rules of Court 2012. That affidavit was affirmed in Japan before a notary public. As Japan is a non-Commonwealth country, that affidavit should be made before a Malaysian consular officer for otherwise it must be rejected: *Malaysian Newsprint Industries Sdn Bhd v Bechtel International Inc & Anor* [2013] MLJU 866.

[18] Having perused the affidavit, I rule that the impugned PW1's affidavit complies with the legal requirements as it was properly affirmed before a Consular officer and can be accepted in evidence.

PW1's standing as an expert witness

[19] The defendant argued that PW1 cannot be accepted as an expert as he does not hold the appropriate qualification, he was biased and not independent as he has a close business relationship with the first plaintiff, and his expert report bears similarities with the first plaintiff's documents. In essence PW1 does not pass the test of an expert as set out in *Batu Kemas Industri Sdn Bhd v Kerajaan Malaysia Tenaga Nasional Bhd* [2015] 5 MLJ 52; [2015] 7 CLJ 849 where the Court of Appeal established the tests in determining whether a person is an expert as follows:

[36] What are the duties and responsibilities of expert witnesses? It is useful to

consider what Ian Freckelton and Hugh Selby the authors of *Expert Evidence — Law, Practice, Procedure and Advocacy* (Lawbook Co 2005 3rd Ed) described as the most important enunciation of the duties and responsibilities of expert witnesses in the context of *National Justice Compania Naviera SA v Prudential Assurance Co Ltd ('The Ikarian Reefer')* [1993] 2 Lloyd's Rep 68 at pp 81–82 which has since been applied in *National Justice Compania Naviera SA v Prudential Assurance Co Ltd ('The Ikarian Reefer')* [1995] 1 All ER 577 at p 60:

> The duties and responsibilities of expert witnesses in civil cases include the following:
>
> (1) Expert evidence presented to the court should be, and should be seen to be, the independent product of the expert uninfluenced as to form or to content by the exigencies of litigation (*Whitehouse v Jordan* [1981] 1 WLR 246 at 256–257; [1981] 1 All ER 267 at 276 per Lord Wilberforce).
>
> (2) An expert witness should provide independent assistance to the court by way of objective unbiased opinion in relation to matters within his expertise (see *Polivitte Ltd v Commercial Union Assurance Co Plc* [1987] 1 Llyod's Rep 379 at 386 per Garland J and *Re J* [1991] FCR 370 per Cazalet J). An expert witness in the High Court should never assume the role of an advocate.
>
> (3) An expert witness should state the facts or assumptions upon which his conclusions are based. He should not omit to consider material facts which could detract from his concluded opinion (*Re J*).
>
> (4) An expert witness should make it clear when a particular question or issue falls outside his expertise.
>
> (5) If an expert's opinion is not properly researched because he considers that insufficient data is available, then this must be stated with an indication that the opinion is no more than a provisional one (*Re J*). In cases where an expert witness who has prepared a report could not assert that the report contained the truth, the whole truth and nothing but the truth without some qualification, the qualification should be stated in the report (*Derby & Co Ltd v Weldon* (1990) Times, 9 November per Staughton LJ).
>
> (6) If, after exchange of reports, an expert witness changes his view on a material matter having read the other side's expert's report or for any other reason, such change of view should be communicated (through legal representatives) to the other side without delay and where appropriate to the court.

[37] As an independent aid to the court, it is therefore essential that an expert witness must possess and retain a standard of absolute personal integrity. In this connection, Cazalet J in *Re J*, said:

> Expert witnesses are in a privileged position: indeed only experts are permitted to give an opinion in evidence. Outside the legal field the court itself has no expertise and for that reason frequently has to rely on the evidence of experts.

A Such experts must express only opinions which they genuinely hold and which are not biased in favour of one particular party. Opinions can, of course, differ and indeed quite frequently experts who have expressed their objective and honest opinion will differ, but such differences are usually within a legitimate area of disagreement. On occasions, and because they are acting on opposing
B sides, each may give his opinion from different basic facts. This of itself is likely to produce a divergence.

[20] The Court of Appeal then went on to explain that before the court can
C accept the testimony of the expert, the competency of the expert witness must be established. The test is as set out in *Junaidi bin Abdullah v Public Prosecutor* [1993] 3 MLJ 217; [1993] 4 CLJ 201 (SC), where the Supreme Court made the following observations:

D First, does the nature if the evidence require special skill? Second, if so, has the witness acquired the necessary skill either by academic qualification or experience so that he has adequate knowledge to express an opinion on the matter under enquiry? The answer to both questions must necessarily depend on the facts of each particular case. The speciality of the skill required of an expert witness under s 45 would depend on the scientific nature and complexity of the evidence sought to be
E proved. The more scientific and complex the subject matter, the more extensive and deeper will be the court required to enquire into the ascertainment of his qualification or experience in the particular field of art, trade or profession. But in the final analysis in a non-jury trial, it is for the trial judge himself as both judge of fact and law to determine the weight to be attached to such evidence notwithstanding the outstanding qualification or experience (or lack of it) of the
F expert.

[21] Having ascertained PW1's academic qualification and CV, and having examined his evidence before me, I found that PW1 had acquired the necessary
G skill by his academic qualification and combined with his work experience, and that he has adequate knowledge to express an opinion on the matter under enquiry before this court. I found that PW1 has the speciality of the skill required in the termite control industry, particularly the termite-proofing method implemented through a reticulation pipe system comprising two
H sub-systems of tubes employed by the plaintiffs in the plaintiffs' works. Granted that PW1 is not a copyright expert but his evidence is not required at this court for that area. He was not an expert to assist this court in the area of copyright of the pest control system.

I **[22]** Apart from that, despite PW1's close association with the plaintiffs, I do not find that fact per se should bar him from giving testimony as an independent expert. PW1 was fiercely cross-examined in great detail by the defendant's counsel and his expertise in the subject matter that he was meant to assist the court was put to test.

[23] I found PW1 to be a reliable expert witness. His testimony conforms with the requirements as set out by the Court of Appeal in *Batu Kemas* and I found that PW1's evidence was:

(a) uninfluenced as to form or to content by the exigencies of litigation;

(b) objective unbiased opinion in relation to matters within his expertise;

(c) never assume the role of an advocate;

(d) his expert opinion in exh P1 had stated the facts and assumptions upon which his conclusions are based; and

(e) PW1 made it clear that copyright falls outside his expertise.

[24] Based on the above findings, I do not agree with the defendant counsel that this court must reject PW1's expertise and his expert evidence. I accept PW1's expert report as in exh P1 to substantiate PW1's oral evidence before this court.

Locus standi of the plaintiffs

[25] The defendant argued that the plaintiffs had no locus standi to bring this action against the defendant.

[26] The plaintiffs had evidenced the statutory declaration ('SD') dated 17 December 2019 of Mr Phua Weng Choy (PW5) made pursuant to s 42 of the CA 1987, (exh P9), as proof of the first plaintiff's ownership of the plaintiff's works, and consequently the locus standi of the first plaintiff to bring this action against the defendant. The evidence of PW5 during trial was as below:

KCP: Your SD already stated that the author is Bradley, is that what you're saying?

PW5: Yeap

...

PW5: Page 63. Now it has got Bradley Mann, Phil Hearse, Phillip Hannay and David Clarke, so it's number 2, 3 and 4.

KCP: So we have identified altogether, 4 authors now.

PW5: 4, 4 now.

KCP: Yeap.

PW5: All right.

KCP: 4, 4, 4 authors of your so-called copyrighted work, correct?

PW5: Yeah. Page number 87

KCP: Is that correct, Mr. Phua?

PW5: Yes, correct.

KCP: Yes. Yes, 87?

PW5: It's the same, we added David Clarke, I think.

KCP: Okay.

...

PW5: Yeah, even if you refer, you look at 341, before Termguard IP it's Termguard Pty Ltd, then it transferred to Termguard IP before it transferred back to Termguard Pty. 341, there's two name of former name. So it started with Termguard Proprietary Ltd transfer to Termguard Intellectual Property Proprietary Limited, transferred back to Termguard Pty Ltd

[27] By virtue of the copyright licence agreement between first plaintiff and second plaintiff (exh P10), the second plaintiff was given exclusive and non-transferrable licence to use the plaintiffs' work in the course of its business in Malaysia. That agreement is in consonant with s 27(3)–(6) of the CA 1987. By virtue of s 38(2) and (3) of the CA 1987, the second plaintiff has the same rights of action as the first plaintiff, and is cloaked with the appropriate locus standi to take this action against the defendant.

[28] This court had considered the evidence produced by the plaintiffs including the SD. Having considered the said evidence and the testimonies of the witnesses, it is this court's finding that the plaintiffs had successfully proven, on the balance of probabilities, that the first plaintiff is the owner of the plaintiff's works, and the plaintiffs possesses the locus standi to bring this action against the defendant.

Is the plaintiffs' works copyrightable?

[29] To answer this question, this court relied on the decision of the Federal Court in *YKL Engineering Sdn Bhd v Sungei Kahang Palm Oil Sdn Bhd & Anor* [2022] 6 MLJ 1; [2022] 8 CLJ 32 which held that in determining the subsistence of copyright, reference has first to be made to s 7 of the CA 1987. The relevant provisions of s 7 are as follows:

7(1) Subject to this section, the following works shall be eligible for copyright:

(a) literary works;

(b) musical works;

(c) artistic works;

(d) films;

(e) sound recordings; and

(f) broadcasts.

(2) Works shall be protected irrespective of their quality and the purpose for which they were created.

(2A) Copyright protection shall not extend to any idea, procedure, method of operation or mathematical concept as such.

(3) A literary, musical, or artistic work shall not be eligible for copyright unless:

(a) sufficient effort has been expended to make the work original in character; and

(b) the work has been written down, recorded, or otherwise reduced to material form.

(4) A work shall not be ineligible for copyright by reason only that the making of the work, or the doing of any act in relation to the work involves an infringement of copyright in some other work.

[30] Pursuant to s 7(1) above, 'artistic works' are eligible for copyright. Artistic works are defined in s 3 to include a 'graphic work' which in turn is defined to include any 'drawing'.

[31] Subsection 7(3) qualifies further to provide that in order for artistic works to be eligible for copyright, sufficient efforts must have been expended to make the artistic works, including drawing, original in character and the works must have been reduced to material form. However, the fact that a work is based on the existing work, or parts of the work is lifted from another work will not prevent it from being original as stated in s 7(4) of the CA 1987.

[32] Having referred to the above provisions, the Federal Court held:

[101] It can be summed up from the above provisions that, for copyright to subsist, the work must be

(a) original;

(b) complies with the requirement as to form;

(c) belongs to one of the categories of protected works; and

(d) complies with the qualifications for copyright.

Once these requirements are fulfilled, a work is protected irrespective of quality and the purpose for which it was created (see Khaw Lake Tee and Tay Pek San, *Khaw on Copyright Law in Malaysia* (4th Ed, Lexis Nexis 2017) p 33).

[102] The concept of 'originality' in copyright was addressed and carefully deliberated in the English case of *University of London Press, Limited v University Tutorial Press, Limited* [1916] 2 Ch 601. Similar concept was adopted by this court in *Lau Foo Sun v Government of Malaysia* [1974] 1 MLJ 28[1969] CLJU 78[1969] 1 LNS 78 and *Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor* [2015] 3 MLJ 1; [2015] 1 CLJ 887. In *Dura-Mine*, this court had emphasised that it was not a requirement for the expression to be in an original or novel form before a copyright can be said to subsist. The copyright law does not require that a work should be unprecedented or new in comparison with already existing works.

A [103] What we can conclude from the above discourse is that the concept of 'newness' or 'novelty' in the patent law is not a relevant consideration for copyright to subsist. What is more important is that sufficient efforts have been expended to render the work original in copyright law as clearly articulated in s 7(3)(a).

...

B [105] The application of this provision of the law was explained by Associate Professor Dr Tay Pek San in *Intellectual Property Law in Malaysia* (2nd Ed, Sweet Maxwell 2020) where it was observed that a creator or author of an original work is entitled to copyright even though he may have infringed the copyright of any work which he has drawn or copied from.

C [106] The legal proposition is clear that a work shall not be ineligible for copyright merely by reason that the making of the work involves an infringement of copyright in some earlier or other works. What is essential for a subsistence of copyright in such work is the sufficient effort expended in terms of time, labour and skills to render the same original.'

D

[33] Firstly, I am satisfied that the plaintiffs' works fall within the meaning of 'artistic work' that is protected under the CA 1987. Pursuant to s 7(1) above, 'artistic works' are eligible for copyright. Artistic works are defined in s 3 to E include a 'graphic work' which in turn is defined to include any 'drawing'. The plaintiffs' works in the form of the drawings are found to be original in character and had been reduced to material form. The plaintiffs had shown to this court that sufficient efforts have been expended to render the plaintiffs' work original in copyright law as provided in s 7(3)(a) of the CA 1987.

F

[34] Having perused the evidence before me, I concluded that the plaintiffs had successfully shown that the plaintiffs' works claimed before this court — as shown in paras 11(a)–(c) of the plaintiffs' SOC — are original, complies with the requirement as to form, and it belongs to one of the categories of protected G works. The plaintiffs' works comply with the qualifications for copyright protection.

Claims of copyright subsistence and copyright ownership of the plaintiff's works via statutory declaration

H

[35] I come to the conclusion that the plaintiffs' claim on copyright over the plaintiffs' works pertains to the design drawings and its appurtenances of the first plaintiff's two-hole reticulation system for control of subterranean termites created by its employees, which had subsequently been reduced to I material form, as particularly described in paras 11(a)–(c) of the plaintiffs' amended SOC, and shown in the earlier paragraph. The plaintiffs argued that the first plaintiff had expended substantial effort to render the drawings original in character as envisaged under the copyright law. The plaintiffs maintained that the design drawings are artistic works within the meaning of s

7(1)(c) of the CA 1987.

[36] As stated in the earlier paragraph, the plaintiffs had evidenced the statutory declaration dated 17 December 2019 of Mr Phua Weng Choy (PW5) made pursuant to s 42 of the CA 1987 (exh P9), as proof that the first plaintiff had expended substantial effort into the design drawings of the said termites control system, and also as proof of the first plaintiff's ownership of the plaintiff's works,

[37] Section 42 of the CA prescribes the manner of proving copyright subsistence and ownership of copyrightable works.

[38] This court agrees with the plaintiffs' counsel that the principle laid down by the Federal Court in *Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor* [2015] 3 MLJ 1 on the operations of s 42 applies squarely in favour of the plaintiffs vis a vis the admissibility of PW5's evidence supported by the SD. In that case, the Federal Court held:

> (5) Although under s 42(1) of the Act, an affidavit or SD made by or on behalf of a person claiming copyright to any works eligible for copyright must strictly comply with the whole of s 42(1)(a)(i)–(iii) in order to be admissible as prima facie evidence of the facts stated therein, s 42 was far from being the be-all and end-all of proof. For, other than by affidavit or SD, a person claiming copyright could adduce oral evidence and tender other evidence, the admission of which was not precluded by the act. Section 42 provided a means, but not the only means, of proving copyright. As oral evidence was open to cross-examination and therefore was of higher evidential value than affidavit or SD evidence, the court agreed with the pragmatic approach adopted by some courts to allow oral evidence to augment, correct, or even supplant, a defective s 42 affidavit or SD.

[39] In essence, as soon as this court accepted PW5's evidence and exh P9 as prima facie proof of the first plaintiff's copyright ownership of the works, at that point in time, the defendant must adduce positive evidence to displace the evidentiary presumption: *Honda Giken Kogyo Kabushiki Kaisha v Mforce Bike Holdings Sdn Bhd & Anor and another suit* [2017] MLJU 1576 (HC).

[40] Azahar Mohamed J (as His Lordship then was) in *Elster Metering Ltd & Anor v Damini Corp Sdn Bhd & Anor* [2011] 8 MLJ 253; [2010] 1 LNS 397, having referred to *Microsoft Corporation v Yong Wai Hong* explained further the effect and purpose of s 42 as follows:

(a) s 42 provides that an affidavit or statutory declaration (SD) made by the copyright owner or persons authorised by the copyright owner shall be admissible in any proceedings as prima facie evidence of the facts contained therein;

(b) the SD circumvents the requirement of having to produce supporting documentary evidence, which may be antiquated and voluminous (see: *Rock Records (M) Sdn Bhd v Audio One Entertainment Sdn Bhd* [2005] 3 MLJ 552; [2005] 1 CLJ 200, *Microsoft Corporation v Yong Wai Hong* [2008] 3 MLJ 309; [2008] 6 CLJ 223); and

(c) the intention of the Legislature when enacting s 42 is to make it convenient for copyright owners, especially foreign copyright owners, to enforce their rights in Malaysia.

[41] There are five prerequisites that the plaintiffs must fulfilled for the SD to be acceptable under s 42:

(a) it must be made by or on behalf of the person claiming to be the copyright owner;

(b) it must state the copyright subsists in the work at the time specified;

(c) it must specify that the person affirming the SD or the person named therein is the owner of the copyright;

(d) a true copy of the work is annexed; and

(e) the person who is authorised to act on behalf of the copyright must produce such an authorisation in writing (see: *Chong Kak Hau v Public Prosecutor* [2009] 8 CLJ 10; [2008] 1 LNS 734 and *Rajagopal a/l Santhanam v Public Prosecutor* [1998] MLJU 250; [1998] 1 LNS 485).

[42] I found the SD satisfies the five preconditions stipulated in s 42 as explained by the authorities I cited.

[43] Having fulfilled the prerequisites and by virtue of sub-s 42(2), the contents of the plaintiff's SD, with regards its copyright ownership claim, and having ruled that the plaintiffs' works is copyrightable, the plaintiffs has provided prima facie evidence on the ownership of the copyright in the plaintiffs' works. This is in with decision of the Court of Appeal in *Microsoft Corporation v Yong Wai Hong* [2008] 3 MLJ 309; [2008] 6 CLJ 223 as follows:

> The effect of s 42 is to provide prima facie evidence of the fact that the appellant's ownership of the copyright over several works in question. It was then for the respondent to provide positive evidence to displace the appellant's prima facie ownership, for example, by showing that some other person is the true owner of the claimed copyright.

[44] Having scrutinised the SD, I found that it fulfilled the requirement of s 42 of the CA, in that Mr Phua Weng Choy being authorised by the owner of the copyright of the works claimed to be eligible for copyright under the CA 1987 had affirmed the SD stating that:

(a) at the time specified in the SD, copyright subsisted in such work; A

(b) Termguard Pty Ltd, the first plaintiff, is the owner of the copyright; and

(c) a copy of the work annexed to the SD is the true copy of that work.

[45] This court found that the defendant failed to adduce any positive B evidence to displace the plaintiffs' evidence of copyright ownership.

[46] Apart from the SD, through the evidence of PW5, this court concluded that in some part of the plaintiffs' works have only Bradley Mann as the author. C Subsection 10(1) of the CA 1987 provides that copyright shall subsist in every work eligible for copyright of which the author or in the case of a work of joint authorship, any of the authors is, at the time when the work is made, a qualified person.

D

[47] Therefore, it is the finding of this court that the plaintiff had successfully showed to this court that Bradley Mann, being one of the authors, at the time when the copyright work is made, is a qualified person. Therefore, pursuant to s 10(2) of the CA 1987, copyright shall subsists in the plaintiffs' work which is a work eligible for copyright. E

[48] This court further rule that the copyright on the plaintiffs' works conferred by s 10 of the CA 1987 vests initially on Bradley Mann who was the former employee of the first plaintiff, and by virtue of s 26 of the CA 1987 , the copyright shall be deemed to be transferred to the person who commissioned F the work, the first plaintiff: *Microsoft Corp v Conquest Computer Centre Sdn Bhd* [2015] 7 MLJ 243 (HC).

[49] I found that the plaintiffs has successfully established that copyright subsists in the plaintiffs' works and the first plaintiff is the owner thereof. G

Copyright infringement

[50] On what constitute infringement of copyright, this court refers to the Federal Court's decision in *YKL Engineering Sdn Bhd* where it was held: H

> [125] The infringement of copyright is dealt with in s 36 read together with s 13(1) of the CA 1987. Copyright is infringed under s 36, by any person who does, or causes any other persons to do, without the license of the owner of the copyright an act, the doing of which is controlled by copyright under the Act.
>
> [126] Amongst the acts controlled by copyright law under the Act are stipulated under s 13(1) which gives the exclusive right against: I
>
> (a) the reproduction in any material form;
>
> ...

A (e) the distribution of copies to the public by sale or other transfer of ownership;

...

of the whole work or a substantial part thereof, either in its original or derivative form provided that:

B [127] The three elements required for establishing copyright infringement are set out in the High Court case of *Megnaway Enterprise Sdn Bhd v Soon Lian Hock (sole proprietor of the firm Performance Audio & Car Accessories Enterprise)* [2009] 3 MLJ 525; [2009] 8 CLJ 130. It referred to the three essential elements constituting copyright infringement as set out by the English case of *Purefoy Engineering Co Ltd* C *v Sykes Boxall & Co Ltd & Ors* [1955] 72 RPC 89.

[128] The learned trial judge in *Megnaway* too referred to the text by Professor Dr Khaw Lake Tee in *Copyright Law in Malaysia* (1st Ed, Butterworths Asia 1994) where at paras 87 to 88, she explains that for purposes of direct infringement, it must be established that:

D (a) there is sufficient objective similarity between the original work or a substantial part thereof, and the infringing copy;

(b) there is a causal connection between the original work and the infringing copy, that is, the infringing copy must have been copied from the original work, whether directly or indirectly; and E

(c) what has been infringed must constitute a substantial part of the original work.

[129] From the above discussions the law on infringement of copyright is clear and well settled. To prove direct infringement of copyright, all the three elements must F be present cumulatively. These three elements are; sufficient objective similarity, substantial reproduction of the copyrighted and there must be a causal connection between the two works.

[130] In determining sufficient objective similarity between the two works, Gunn Chit Tuan J in *Longman Malaysia Sdn Bhd v Pustaka Delta Pelajaran Sdn* G *Bhd* [1987] 2 MLJ 359 [1986] CLJU 84; [1986] 1 LNS 84 held that besides proving there is objective similarity, there must also be established that the degree of the objective similarity must be substantial. His Lordship went on to explain that the substantiality is required to be established not merely because of the physical amount of reproduction, but more because of the substantial significance of that which was copied. This principle is important to be borne in mind in order to H ensure that the particular similarities relied on, are more likely to be the result of copying and not of mere coincidence.

...

[135] The need to prove causal connection between the two works are indispensable as copyright work must be shown to be a causa sine qua non of the infringing work. I As clearly stated by Diplock LJ in *Francis Day & Hunter Ltd And Another v Bron And Another* [1963] Ch 587, which was referred in the case of *Elsler Metering Limited & Anor v Damini Corporation Sdn Bhd & Anor* [2012] MLJU 1753; [2012] CLJU 959; [2012] 1 LNS 959; 'If the existence of the copyright work has no causal connection with the production of the alleged infringing work (even though the

latter be identical with the former) there is no infringement of copyright'.

[136] To succeed on a claim on infringement the appellant bears the burden of proving the elements of sufficient objective similarity and causal connection between the two works as outlined. The burden is always on the appellant to establish those ingredients by evidence, only then it will give rise to an inference that respondents had copied the appellant's work. The burden on the respondents then is to rebut that inference. The appellant had failed to establish all these three elements cumulatively to succeed on its claim of infringement.

[51] The decision above sets out the law very clearly that for the plaintiffs here to succeed in their claim that defendant had infringed the copyright in the plaintiffs' works, the plaintiffs shall establish to the satisfaction of this court that:

(a) there is sufficient objective similarity between the original work or a substantial part thereof, and the infringing copy;

(b) there is a causal connection between the original work and the infringing copy, that is, the infringing copy must have been copied from the original work, whether directly or indirectly; and

(c) what has been infringed must constitute a substantial part of the original work.

[52] All three elements are to be proven conjunctively. All three must exist.

[53] In *YKL Engineering* the Federal Court scrutinised the findings of the learned trial judge and held that despite concluding that all the three elements as set out under s 7 of the CA 1987 have been met, the learned trial judge failed to provide the analysis that he took to satisfy himself that the objective similarities and the substantial reproduction were positively proven. The Federal Court held that the learned judge must analyse how the element of copying a substantial part of the copyrighted work had taken place, and must explain how and why and what were the similarities which constitute a substantial part of the copyrighted work. The learned trial judge was found to have shown the analysis he took for the causal connection element.

[54] To succeed on a claim on infringement the plaintiffs bears the burden of proving the elements of sufficient and substantial objective similarity and causal connection between the two works as outlined. The burden is always on the plaintiffs to establish those ingredients by evidence, only then it will give rise to an inference that the defendant had copied the plaintiffs' work. The burden on the defendant then is to rebut that inference.

[55] In determining sufficient objective similarity between the two works, Gunn Chit Tuan J (as His Lordship then was) in *Longman Malaysia Sdn Bhd*

v Pustaka Delta Pelajaran Sdn Bhd [1987] 2 MLJ 359; [1986] 1 LNS 84 held that besides proving there is objective similarity, there must also be established that the degree of the objective similarity must be substantial. His Lordship went on to explain that the substantiality is required to be established not merely because of the physical amount of reproduction, but more because of the substantial significance of that which was copied. This principle is important to be borne in mind in order to ensure that the particular similarities relied on, are more likely to be the result of copying and not of mere coincidence.

[56] The main evidence furnished by the plaintiffs to prove that the defendant had infringed the plaintiffs' works are found in the testimony of PW5 in his written statement ('WSPW5'), supported by the evidence of the plaintiff's expert, PW1 and PW1's expert's report in exh P1, reproduced as below:

> Q23. Why do you say the Defendant has infringed the Plaintiffs' Copyrighted works?
>
> A. The Defendant have omitted and/or attempted to mislead and cause, enable and/or assist others in the neglect of the Plaintiffs copyrighted literature and artistic works in drawing, and the diagram of the components of the location of the two-hole in the Termguard Reticulation System and written artistic explanation and the originality in the expression of idea in drawing, the diagram of the components and the literature for termite control offered to control the subterranean termites which INCLUSIVE of termite-proofing system, chemical treatment system and method, termite-proofing installation and method of termite proofing a cavity walled structure.
>
> INFRINGEMENT
>
> (a) Prior to the commencement of this action, the Defendant had tendered offer for Kemaman Hospital Project and Putrajaya Hospital Project and installed and sold and /or continue to offer for installation/sale and selling and/or threaten and intended to continue offer for installation/sale of system components of anti-termite and similar written explanation.
>
> (b) sufficient similarities and causal connection or substantial similarity of Plaintiffs' literature and/or artistic works in drawing and the diagram of the components of the location of the two-hole anti-termite system and the elaboration or explanation of the writing till it likely to cause confusion.

[57] PW5 in that same written statement had further explained the plaintiffs' proof of the defendant's infringement, in the same manner as set out in paras 11(a), (b) and (c) of the plaintiffs' amended SOC.

[58] This court had not only examined the evidence of PW5, PW1 and the defendant's witnesses, but in line with the decision of the Federal Court in *YKL Engineering*, this court had examined and viewed the physical copies of the

plaintiffs' works and the defendant's infringing products. To determine whether the plaintiffs had proven the requisite elements, I had conducted analysis in the following manner:

(a) conducting a side-by-side comparison of the photographs of the plaintiffs' sample board as in exh P19 with the photographs of the defendant's sample board as in exh D1; and

(b) examining the display mockup of the plaintiffs' and the defendant's reticulation piping system as in exh P25.

[59] Through that examination and comparison of the exhibits before this court, I came to the conclusion that although there exist objective similarities between the defendant's infringing product and the plaintiffs' works, the plaintiffs failed to show that the objective similarities are substantial. The similarities were minor in nature, in that they both contain reticulated coils. I applied the principle laid down in *Longman Malaysia Sdn Bhd* and I found that the plaintiffs failed to reveal a substantial objective similarity between the plaintiffs works and the defendant's infringing work.

[60] It is my finding that the plaintiffs' failure to prove the first element would mean that there is no necessity for this court to deal with the second and third elements. The conclusion that must be drawn by this court is that there is no infringement of copyright by the defendant of the plaintiffs' works.

Passing off

[61] Both counsels are in agreement as to what constitute passing off, which is rooted in common law.

[62] The House of Lords in *Reckitt & Colman Products Ltd v Borden Inc And Others* [1990] IAU R 877; [1990] LRC (Comm) 417 set out the following elements to prove passing off:

> The law of passing off can be summarised in one short general proposition, no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Second, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer

A or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely on a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Third, he must demonstrate that he
B suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

C (See application of the above principle in *Ho Tack Sien & Ors v Rotta Research Laboratorium SpA & Anor* [2012] 8 CLJ 645 (CA), *Yong Sze Fun & Anor (t/a Perindustrian Makanan & Minuman Layang-Layang) v Syarikat Zamani Hj Tamin Sdn Bhd & Anor* [2012] 1 MLJ 585; [2011] 1 LNS 1307 and *Ortus Expert White Sdn Bhd v Nor Yanni bt Adom & Anor* [2022] 2 MLJ 67; [2022] 2 CLJ 661 (FC).)
D

[63] In short, in order to succeed in its claim against the defendant for the tort of passing off, the plaintiffs must establish:

E (a) goodwill or reputation attached to the plaintiffs' work by association with a particular get up which would be recognised by the public as distinctive of the plaintiffs' goods and services (goodwill or reputation);

(b) a misrepresentation on the part of the defendant which is likely to lead the public to believe the goods sold by the defendant are those of the
F plaintiffs' (misrepresentation); and

(c) that the plaintiffs had suffered or will suffer loss due to the defendant's misrepresentation (damage).

G *Goodwill and reputation*

[64] On the first element of goodwill or reputation, having evaluated the evidence before me, including the evidence pertaining to the history of the plaintiffs as shown in exh P8 purporting to show the length of time that the
H plaintiffs had been in the business related to the termite control, I concluded that the plaintiffs are a relatively known household name for termite control in Malaysia. I found that so is the defendant. I conducted a simple Google search using 'the most reliable termite control company in Malaysia' and 'the most popular termite control company in Malaysia' and the like as the search terms,
I neither the plaintiffs' nor the defendant's name appear in the top 10 list.

[65] However, being famous and well-known per se does not equal having acquired and established goodwill and reputation. For the plaintiffs to

successfully prove that it has acquired goodwill and reputation, the plaintiffs must satisfy this court that the plaintiffs' works are known to the buyers by some distinctive get up or features.

[66] Briefly, get up of a product refers to the form in which the owner of a particular product presents that product to the public and the market at large. This would typically includes the labelling, packaging, and features such as colour, graphics, design and other such elements. In the context of the plaintiffs' works, it is the whole visible external appearance of the reticulation system must likely to be seen by the public before purchase: Christopher Wadlow in 'The Law of Passing Off' cited in *Thye Huat Chan Sdn Bhd v Thye Shen Trading Sdn Bhd & Anor* [2008] 6 MLJ 99; [2008] 6 CLJ 915.

[67] The plaintiffs argued that its reticulated coil system constitutes distinctive get up and distinctive features that comprise the look and feel, colour and shape of its termite control system.

[68] The facts in *Alfa Laval (M) Sdn Bhd v Ng Ah Hai & Ors* [2008] 5 MLJ 344; [2009] 7 CLJ 1 is akin to the facts here. This court applied in full force the principle laid down in that case which involved a claim for passing off relying on disseminative features, as in the case here. *Alfa Laval* was not relying on their trademark 'Alfa Laval' under which their heat plate exchangers are admittedly sold, but it says its products are heat plate exchangers with special attributes in terms of the features which they claim are distinctive. Alfa Laval argued that three dimensions of the plates in terms of width, length, positions of the inlets and outlet parts and the pressing depth are functional to meet the functional 'must fit' requirement. They enable the plates to be assembled and stacked together in the plate heat exchangers. The 'chocolate' and 'herringbone' patterns are also functional. Ramly Ali J (as His Lordship then was) found that there was no evidence to demonstrate that these functional attributes are distinctive of the plaintiff's heat plate exchangers in the sense described and explained above so as to have enabled them to earn goodwill. His Lordship held that the court was left in doubt when *Alfa Laval* failed to show evidence on the legal distinctiveness that is required for passing off. This is so because the plate heat exchangers are sold by reference to the brand 'Alfa Laval'. It is this brand that is acknowledged as the source identifier not those functional attributes. The publicity and promotion was for the brand 'Alfa Laval' and the plate heat exchangers are of a purely functional design. Such purely functional designs cannot form the basis for a valid distinctive get up for passing off.

[69] I had asked the same question as the learned judge did in *Alfa Laval* — whether the reticulated coil is distinctive of the plaintiffs' so as to have them earn goodwill? This court concludes that the reticulation coiling system which is functional or utilitarian characteristics of the plaintiffs' works are not

protectable under passing off law for they simply in law and on the facts cannot be legally distinctive. The plaintiffs' termite control system is purchased because they perform the function and purpose required by the purchaser, not because these functional attributes, which are more appropriately protected under patents or industrial designs. No consumer would be able to tell that a particular termite control system belongs to the plaintiffs, even by looking at the reticulated coil design. The consumer will only be able to do so by identifying the plaintiffs' brand name emblazoned on their termite control system. This court concluded that the plaintiffs had not fulfilled the burden required of it to prove that the distinctiveness of the plaintiffs' works and that it has generated goodwill.

[70] This court found that the plaintiffs had failed to do so. Its claim under this heading was therefore dismissed.

Misrepresentation

[71] Again, both counsels were consensus as to what constitute misrepresentation. In short, it is a question to be answered by this court having appraised the facts and evidence before me, taking into account the principle laid down by many authorities that the ordinary sensible members of the public and not any small unobservant section of the society has been or likely been deceived or confused by the defendant's misrepresentation. By that, there is no need for the plaintiffs to prove intention to deceive by the defendant nor actual confusion need to be proven by the plaintiffs.

[72] The determination of misrepresentation is a matter for this court to decide, not just by evidence of confusion but on the assessment of the totality of the evidence before the court. The absence of evidence of actual confusion would not necessarily be fatal to the claim as likelihood of confusion would suffice.

[73] Again, the key question needed to be answered by the plaintiffs is whether the plaintiffs' had proven distinctive get up in the plaintiffs' works, that when those get up are replicated by the defendant in its products of the same with that of the plaintiffs, it would cause deception and confusion to the public into believing that those are the plaintiffs' termite control system and consequently injure the plaintiffs.

[74] Having considered and examined the exhibits before me as I had indicated in the earlier paragraphs, I conclude that the plaintiffs' claim that the plaintiffs' works contain distinctive get up cannot be sustained. It is my finding that the reticulation coil applied on the plaintiffs' termite control system are common and nothing distinctive.

[75] I further rule that the concerned members of the public would not be confused or deceived into believing that the defendant's products, even if they carry the reticulation coil system, are that of the plaintiffs'. There was no misrepresentation by the defendant. The defendant's logo depicts clearly the defendant's brand. This court must look at the perception of the ordinary sensible members of the public and not any small unobservant section of the society. I conclude that no ordinary sensible members of the public would be deceived to think that they are buying the Termguard termite control system when they paid for Rapidkill termite control system.

[76] I am further satisfied that the issue of the defendant's website replicating the plaintiff's website has been explained in the evidence of DW 1. I see no mala fide intent of the defendant in copying the plaintiff's website as I accept, on the balance of probabilities, DW1's testimony on the creation of the defendant's website using the plaintiffs' website as a reference.

[77] Based on the above findings, I conclude that the plaintiffs failed to prove the element of misrepresentation.

Damages

[78] As I had dealt with the two fundamental elements of passing off, namely goodwill and misrepresentation and answered both in the negative, I do not need to deal with this third element of damage, adopting a similar approach by the Court of Appeal in *Meidi (M) Sdn Bhd v Meidi-Ya Co Ltd, Japan & Anor* [2008] 6 MLJ 433; [2008] 1 CLJ 46, the decision of which had been affirmed by the Federal Court (see *Meidi-Ya Co Ltd, Japan & Anor v Meidi (M) Sdn Bhd* [2009] 2 MLJ 14; [2009] 2 CLJ 15). In this case the Court of Appeal held:

> Next is on issue of damage. Damage is a critical element in an action for passing off. In the absence of damage, the action cannot succeed. And likelihood of damage due to confusion is sufficient for an action for passing off.
>
> (See: *Reckitt & Colman Products Limited v Borden Inc and Others (No 3)* [1990] RPC 341.) However, since in this case the plaintiffs could not even establish the first two elements of passing off there is therefore no necessity for us to deal with the third element.

[79] Based on the considerations above, I ruled that the plaintiffs had failed to prove passing off against the defendant. The plaintiffs' claim for passing off was thus dismissed with costs.

Unlawful interference with trade

[80] The principles on unlawful interference with trade had been set out by Low Hop Bing J (later JCA) in *Megnaway Enterprise Sdn Bhd v Soon Lian Hock*

A [2002] MLJU 433; [2003] 5 CLJ 103 as follows:

> [48] The elements which constitute the tort of unlawful interference with trade or business are:
>
> (1) Interference with the plaintiff's trade or business;
>
> B (2) Unlawful means;
>
> (3) Intention to injure the plaintiff; and
>
> (4) The plaintiff is injured thereby.
>
> (See *Bullen & Leake & Jacob's Precedents of Pleadings* [1990] p 464.)

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[81] This area of tort is considered as still developing in Malaysia. But Malaysian courts had recognised it as a branch of tort and some of its features are clearly defined (see: *H & R Johnson (Malaysia) Bhd v H & R Johnson Tiles Ltd & Anor* [1995] MLJU 54; [1995] 2 CLJ 581).

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[82] In *Ly Furniture Sdn Bhd & Anor v Lifestyle Enterprise, Inc & Anor and another appeal* [2015] MLJU 2347; [2015] 1 LNS 1557, Nallini Pathmanathan JCA (now FCJ) reading the decision of the Court of Appeal held:

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> [111] The significance of the presence of the element of unlawful means in establishing this tort was discussed comprehensively by Lord Nicholls of Birkenhead in *OBG Ltd and others v Allan and others; Douglas and others v Hello! Ltd and others; Mainstream Properties Ltd v Young and others* [2007] UKHL 21 where he held as follows:

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> > Interference with the claimant's business by unlawful means I start with the tort comprising interference with a trade or business by unlawful means or, more shortly, the tort of unlawful interference. The gist of this tort is intentionally damaging another's business by unlawful means. Intention is an essential ingredient. The tort is not one of strict liability for harm inflicted on another's
>
> G business, nor is it a tort based on negligence. The defendant must have intended to inflict the harm of which complaint is made. That is the starting point. I shall have to return to this point later. But intent to harm is not enough. Intentional harm of another's business is not of itself tortious. Competition between businesses regularly involves such business taking steps to promote itself at the
>
> H expense of the other. One retail business may reduce its prices to customers with a view to diverting trade to itself and away from a competitor shop. Far from prohibiting such conduct the common law seeks to encourage and protect it. The common law recognises the economic advantages of competition.
>
> > Unlawful means This is not to say that in this field of economic rivalry anything
>
> I goes. Business people are not free to promote their businesses at the expense of others by whatever means they may choose. There are limits. The common law has long recognised that some forms of conduct, intentionally damaging other traders, are not acceptable ... For these reasons I accept the approach of Lord Reid and Lord Devlin and prefer the wider interpretation of 'unlawful means'. In this context the expression 'unlawful means' embraces all acts a defendant is not

permitted to do, whether by the civil law or the criminal law.

[83] As I had ruled out the defendant's act of passing off against the plaintiffs', and consequential to the finding that the defendant had not infringed the plaintiffs' works copyright, conclude that the plaintiffs failed to show that the defendant had interfered with the plaintiffs' trade or business by unlawful means and with the intention to injure the plaintiffs. Having ruled out these elements, the final element that the plaintiffs were injured by the defendant's act of interference must therefore fail. The plaintiffs' claim under this heading is therefore dismissed.

CONCLUSION

[84] Based on the above findings and considerations, I make the following orders:

(a) firstly, I declare that the first plaintiff owns the copyright of the works as enumerated in para 11(a)–(c) of the amended SOC;

(b) secondly, there is no infringement of that copyright by the defendant; and

(c) thirdly, the defendant did not commit the tort of passing off and unlawful interference with the plaintiffs' trade.

[85] This court further orders the dismissal of the plaintiffs' claims that:

(a) the defendant was unlawfully selling the defendant's infringing work or offering to sell the same;

(b) the defendant unlawfully used the defendant's infringing work in its tender project documents; and

(c) the defendant was reproducing the plaintiffs' works without the plaintiffs' license and permission.

[86] Based on those findings, the plaintiff's claims and prayers in para 31 of their amended SOC are dismissed with costs.

Plaintiff's claim against defendant dismissed.

Reported by Ashok Kumar